

**REMARKS**

The Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-9 and 11-13 are pending. Claim 10 is cancelled herein without prejudice to or disclaimer of the subject matter set forth therein. Claims 1, 4, and 7 are amended, and claims 11-13 are added. Claims 1, 4, 7, and 11-13 are independent. The Examiner is respectfully requested to reconsider the rejections in view of the remarks set forth herein.

**Rejection Under 35 U.S.C. § 103(a)**

Claims 1-10 stand rejected under 35 U.S.C. § 103(a), as unpatentable over Yamada et al. (u.s. 2005/0125381) in view of Uehara et al. (U.S. 2002/0056095) This rejection is respectfully traversed.

**Arguments Regarding Independent Claims 1, 4, and 7**

While not conceding the appropriateness of the Examiner's rejection, but merely to advance the prosecution of the present application, each of independent claims 1, 4, and 7 has been amended to include a combination of features including "... directly printing thumbnail images of said representative images onto a surface of said storage medium disk".

Support for the novel combination of features in claims 1, 4, and 7, can be found in the specification, for example, on page 3, line 16-20. See also FIG. 1, for example, which shows thumbnail images 9 being directly printed onto the surface 8 of the storage medium 7.

In the Office Action (page 3) the Examiner concedes that Yamada et al. fail to disclose the feature of attaching thumbnail images of the representative images of the image files to the surface of the storage medium. However, the Examiner contends that the Uehara et al. reference discloses a video content browsing apparatus which includes the capability of attaching thumbnail images (image index) to a storage medium as specified in claims 1, 4, 7, and 10 of the present application. However, the Examiner fails to show where the limitation specified in the present claims is disclosed in the Uehara et al. reference. Therefore, it is impossible for the Applicants to understand which feature disclosed in the Uehara et al. reference corresponds to the feature of “attaching thumbnail images...” specified in the present claims 1, 4, 7 and 10.

While the Applicants do not agree with the Examiner conclusions, if merely for the sake of argument, the Examiner interprets the “thumbnail image” to be an “image index”, it may be assumed that the Examiner looks on “icon images” illustrated in Fig. 10 of the Uehara et al. reference as corresponding to the image index of the present invention. The Uehara et al. reference may disclose displaying icon images of a video content segment on a display in Fig. 10. However, it shows only displaying the icon image on a display and that is not equal to “attaching image index” to a storage medium.

Another possibility that the Examiner may have considered is that the “printing apparatus” of Fig. 12 is considered a means for carrying out attaching thumbnail images (image index) to a storage medium. According to Uehara et al. paragraph [0126], “Video

content storing part (43)” of Fig. 12 prints the image index generated by the classification and arrangement display part 48 through a printing apparatus such as a color printer, when a user specific printing of the image index. Further, Uehara et al. paragraph [0126] indicates that the image index may also be printed in a label and attached to a case of a DVD medium. However, there is no mention whatsoever regarding the thumbnail images of the representative images being directly printed onto the surface of the storage medium disk. Regarding the printing apparatus, the Uehara et al. reference merely indicates “a printing apparatus such as a color printer”, and does not teach or suggest the printing apparatus capable of directly printing thumbnail images onto the surface of the storage medium disk, as set forth in claims 1, 4, and 7 of the present invention.

At least for the reasons set forth above, the Applicants respectfully submit that the references cited by the Examiner, including Yamada et al. and Uehara et al., fail to teach or suggest the combination of novel features set forth in any of independent claims 1, 4, and 7.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested. Independent claims 1, 4, and 7, and the claims depending therefrom, are in condition for allowance.

#### **Arguments Regarding Independent Claims 11-13**

The Examiner is advised that independent claims 1, 4, and 7 as originally filed are added herein as new independent claims 11-13.

As the Examiner concedes, the Yamada et al. document fails to disclose attaching thumbnail images of the representative images in the storage medium, as set forth in added independent claims 11-13.

As discussed above regarding the Uehara et al. reference, the Examiner fails to refer to any specific evidence that this document teaches attaching thumbnail images of representative images to a surface of the storage medium. Further, as discussed above, according to Uehara et al. paragraph [0126], "Video content storing part (43)" of Fig. 12 prints the image index generated by the classification and arrangement display part 48 through a printing apparatus such as a color printer, when a user specific printing of the image index. The Applicants respectfully submit that an "image index" is not the same as "thumbnail images of said representative images" as presently claimed.

Further, Uehara et al. paragraph [0126] indicates that the image index may be printed in a label and attached to a case of a DVD medium. However, there is no mention whatsoever regarding the thumbnail images of the representative images being attached to the surface of the storage medium. A "case of a DVD" is not the same as a "surface of a storage medium disk". Still further, regarding the printing apparatus, the Uehara et al. reference merely indicates "a printing apparatus such as a color printer", and does not teach or suggest the printing apparatus capable of attaching the thumbnail images onto the surface of the storage medium disk, as set forth in claims 11-13 of the present invention. Thus, as best understood by the Applicants, the Uehara et al. fail to make up for the deficiency of

Yamada et al., and thus this combination cannot be used to reject added independent claims 11-13.

**Rejection Under 35 U.S.C. § 101**

Claim 10 stands rejected under 35 U.S.C. § 101 as allegedly being directed to a recording medium storing non functional descriptive material. The Examiner proceeds to state "Data structures not claimed ....are descriptive material per se and are not statutory....".

This rejection is respectfully traversed.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance the prosecution of the present application, claim 10 has been cancelled

Therefore, the Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 101 should be withdrawn.

All claims of the present application (claims 1-9 and 11-13) are now in condition for allowance.

**CONCLUSION**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a three (3) month extension of time for filing a reply in connection with the present application, and the required fee of \$1020 is attached hereto.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone Carl T. Thomsen, Registration No 50,786, at (703) 208-4030 (direct line).

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

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Respectfully submitted,  
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